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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,079	07/24/2003	Neville Alleyne	NAS.002A	3511

20995 7590 10/02/2006

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EXAMINER

PHILOGENE, PEDRO

ART UNIT PAPER NUMBER

3733

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/628,079

**Applicant(s)**

ALLEYNE, NEVILLE

**Examiner**

Pedro Philogene

**Art Unit**

3733

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-17 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 4-7,9-13 is/are allowed.
- 6) ☒ Claim(s) 14-17,22-24,26,27,29 and 30 is/are rejected.
- 7) ☒ Claim(s) 25,28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-17,22-24,26,27,29,30 are rejected under 35 U.S.C. 102(b) as being anticipated by Fortin (WO0072768).

Fortin discloses an apparatus comprising at least a superior and an inferior end piece (333), wherein the superior and inferior end pieces could be adapted to be affixed to superior and inferior vertebral bodies, respectively; means (300) for decreasing the distance between the end pieces to bring the apparatus into a compressed arrangement; and means (38,39) for removably coupling during surgery the end pieces to the means for decreasing; as best seen in FIG.14; a parallel set of mating arms (35,36) a means (300) for sliding each arm within each set of mating arms relative to the other mate within the set; as best seen in IFG.14; and as set forth in page 5, lines 20-31, page 8, lines 11-31, page 9, lines 1-23.

With regard to the recitation that an element is “adapted to” or “adapted for”, it is noted that it has been held the recitation that an element is “adapted to” or “adapted for” perform a function is not a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense. In addition, the manner in which a device is intended to be employed, does not differentiate the claimed apparatus from

the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1887).

The method, steps, as set forth, would have been inherently carried out in the operation of the device; as set forth above.

Claims 14,22,26,27 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (5,902,304).

Walker et al., disclose an apparatus comprising at least a superior and an inferior end piece (43,51), wherein the superior and inferior end pieces could be adapted to be affixed to superior and inferior vertebral bodies, respectively; means (40,47) for decreasing the distance between the end pieces to bring the apparatus into a compressed arrangement; and means (42,44,45,46,49,50,52,53,54) for removably coupling during surgery the end pieces to the means for decreasing; as best seen in FIGS. 12, 13, 16, 17; and as set forth in column 9, lines 55-67, column 10, lines 1-67, column 11, lines 1-29.

With regard to the recitation that an element is "adapted to" or "adapted for", it is noted that it has been held the recitation that an element is "adapted to" or "adapted for" perform a function is not a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense. In addition, the manner in which a device is intended to be employed, does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1887).

The method, steps, as set forth, would have been inherently carried out in the operation of the device; as set forth above.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14,22,26,27 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakajima (6,355,036).

Nakajima discloses an apparatus comprising at least a superior and an inferior end piece (43,51), wherein the superior and inferior end pieces could be adapted to be affixed to superior and inferior vertebral bodies, respectively; means (26) for decreasing the distance between the end pieces to bring the apparatus into a compressed arrangement; and means (22,24,50,56,38,34) for removably coupling during surgery the end pieces to the means for decreasing; as best seen in FIG.1; and as set forth in column 3, lines 19-67, column 4, lines 1-67, column 5, lines 1-63.

With regard to the recitation that an element is "adapted to" or "adapted for", it is noted that it has been held the recitation that an element is "adapted to" or "adapted for" perform a function is not a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense. In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1887).

The method, steps, as set forth, would have been inherently carried out in the operation of the device; as set forth above.

***Allowable Subject Matter***

Claims 25,28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1, 4-13 are allowed.

***Response to Amendment***

Applicant's arguments, see Remarks, filed 7/20/06, with respect to the rejection(s) of claim(s) 1-7,9-24 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Fortin/Nakajima/Walter.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7,029,472	4-2006	Fortin
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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

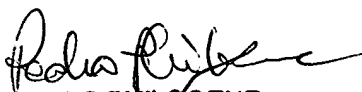
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
September 23, 2006



PEDRO PHILOGENE  
PRIMARY EXAMINER